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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,968	03/08/2000	Reem Safadi	Gen-086	2128

7590	06/01/2005	

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EXAMINER
NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Advisory Action
Before the Filing of an Appeal Brief</td><td colspan="2">Application No.</td><td colspan="2">Applicant(s)</td></tr>
<tr><td colspan="2">09/520,968</td><td colspan="2">SAFADI ET AL.</td></tr>
<tr><td></td><td colspan="2">Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td></td><td colspan="2">HUY T. NGUYEN</td><td>2616</td><td></td></tr>
</table>

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>02 May 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>*1-31 and 39-42*</u>.

   Claim(s) withdrawn from consideration: <u>*32-38*</u>.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See attachment for examiner responses.</u> .

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☐ Other: _____.

Response to Arguments

1.   Applicant's arguments filed 02 May 2005 have been fully considered but they are
not persuasive.

Applicant agues that   "In contrast, the combined teachings of Okuyama and
Logan fail to teach or suggest a recorder or method of recording that includes receipt of
a signal carrying both television programming and other data, such as multimedia files
and software, where the television programming and other data are selectively recorded
on the same data storage device. Okuyama teaches a system in which television
programming is recorded on either a Video Tape Recorder (VTR) or a DVD player.
These devices, as explained by Okuyama, are suitable for recording television
programming delivered, for example, as an MPEG digital transport stream. However,
the VTR and DVD of Okuyama are not used to selectively store television programming
in addition to other data such as multimedia files or software. According to Okuyama, "a
recording/reproducing unit 42 of the DVD 4 is designed to record an inputted transport
stream after converting it into a program stream (PS)." (Okuyama, col. 6, lines 12-14).
Okuyama does not teach or suggest also storing other data such as software or a
multimedia file on the VTR or DVD unit."

In response , it is noted that applicant's argument   does not reflect the claims
limitation . It is noted that claims 1 and 16 recite that "streamed audiovisual content,
multimedia files or software ." Therefore,   Okuyama meets the claims recitation
since Okuyama teaches selectively recording any received video/audio stream of
the transport stream and television programming .

Applicant further argues that "Parenthetically, the final Office Action seems confused as to what constitutes a multimedia file as claimed. According to Applicant's specification, a multimedia file is, for example, a picture file, a graphics file, a video file or an audio file. (Claim 2). By definition, streamed audiovisual programming is not a "file." .

In response, it is noted that claims 1 recites that "streamed audiovisual content, multimedia files or software . Therefore Okuyama meets the claims . Further Okuyama teaches a multimedia files such as a video file or audio file . A video program of the transport stream considered as video /audio file and television programming data is considered as graphic file since each video program having a name , title or ID used for controlling the recording or reproducing . Further , it is noted that "software" recited in claims 1 and 16 without specifying it is a computer software, the claimed software are considered as a video program .

Applicant agues that " Logan also does not teach or suggest a system or method, as claimed, in which a signal is received carrying both television programming and other data such as software or multimedia files and selectively recorded on the same data storage device. Thus, neither of the two cited references teach or suggest a recorder or method of recording that includes receipt of a signal carrying both television programming and other data, such as multimedia files *and* software, where the television programming and other data are selectively recorded **on the same data storage device**. Therefore, the combination of Okuyama and Logan fails to teach or suggest the features of the claims." And "To establish prima facie obviousness of a

claimed invention, all the claim limitations must be taught or suggested by the prior art.

In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord.

M.P.E.P. § 706.020). Therefore, for at least these reasons, the rejection of claims 1-32

and 39-42 should be reconsidered and withdrawn."

In response, it is noted that applicant's argument does not reflect the claims

since nowhere in claims do they recite a signal is received carrying both television

programming and other data such as software and r multimedia files and recording

both the television programming and other data se record on the same data storage

device .

Applicant argues that " Additionally, claim 9 recites: "The recorder of claim 8,

wherein said set-top terminal further comprises a secondary tuner for tuning said data

transport stream, a second data transport stream, or a second selected channel from

the signal received from said cable television system." In contrast, none of the cited

prior art references teach or suggest a secondary tuner that is controlled by the same

controlled by the same central processing unit (claim 10) as that selectively storing both

television programming and other data in a common data storage device.

In response it is noted that applicant's argument does not reflect the claims

since nowhere in claims do they recite that both television programming and other

data from the second user are recorded in a common data storage device.

Applicant argue that "Claim 13 recites: "The recorder of claim 1, further

comprising an agent application executed by said central processing unit for identifying

and recording or caching data from **said data transport stream or television**

programming that matches parameters input by a user."

In response, the examiner disagrees . It is noted that Okuyama teaches use

agent application such as user application (user instruction using program guide)

used for controlling receiving and recording audio/video stream or television

programming .

Applicant argues that "In contrast, Metz appears only concerned with the

transmission of software and not multimedia data files. (Metz, abstract).

In response it is noted that applicant argument does not reflect the claims

since the claims recite that " software or multimedia data files. " See claims 1 and 16.

2.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to HUY T. NGUYEN whose telephone number is (571)

272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Groody can be reached on (571) 272-7950. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PRIMARY EXAMINER